CUSTOMER NO.: 24498
Serial No.: 10/520,854
Office Action dated: June 20, 2008
Response dated: October 10, 2008

PATENT
PU020335

REMARKS

The Office Action mailed June 20, 2008 has been reviewed and carefully considered. No new matter has been added.

Claims 1-2, 4, 11-14, 16-18, and 21-31 are pending.

Claims 23, 25, 29, and 31 have been objected to by the Examiner, as being of improper dependent form for failing to further limit the subject matter of a previous claim. The Examiner reasoned that "Claims 23, 25, 29, and 31 do not further limit Claims 22, 24, 28, and 30, respectively, since the limitations stated are found within independent Claims 1 and 16, which the latter claims depend on and incorporate" (Office Action, pp. 2-3). The Applicant respectfully disagrees.

For example, Claim 23 depends from Claim 22 which, in turn, depends from Claim 4 which, in turn, depends from Claim 1. Claim 1 recites, *inter alia*, "a particular one compatibility parameter of said ALG file" (hereinafter interchangeably referred to as "item 1" for the sake of illustration), a compatibility feature of said bi-directional communications device" (hereinafter interchangeably referred to as "item 2" for the sake of illustration), and a non-signature, non-code-error checking feature expected in received and authentic ALG files by said bi-directional communications device" (hereinafter interchangeably referred to as "item 3" for the sake of illustration), wherein item 1 is compared to the latter two items (i.e., items 2 and 3). Claim 4 further limits Claim 1 (from which directly depends) by further defining the particular one compatibility parameter, i.e., item 1. Claim 22 further limits Claim 1 (from which it indirectly depends) by further defining the at least one compatibility feature, i.e., item 2. Claim 23 further limits Claim 1 (from which it indirectly depends) by further defining the non-signature, non-code-error checking feature expected in received and authentic ALG files by said bi-directional communications device, i.e., item 3. Hence, each of Claims 4, 22, and 23 further limit Claim 1, from which each directly or indirectly depend. Moreover, as is evident from the preceding, the subject matter recited in Claim 23 is not a duplication of that recited in Claim 1 but rather a further limiting of the same. It is respectfully pointed out that a proper dependent claim is not required to further limit the immediately preceding claim from which it depends, but only a claim from which it depends. Accordingly, Claim 23 is a proper dependent claim. The same reasoning is applicable to Claims 25, 29, and 31, as each of these claims further limit a claim from which they respectively directly or indirectly depend. Accordingly, each of Claims 23, 25, 29, and 31 are

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believed to be proper dependent claims. Withdrawal of the objection is respectfully
requested.

  Claims 24, 25, 30, and 31 stand rejected under 35 U.S.C. 112, first paragraph, as
failing to comply with the written description requirement. In particular, the Examiner
asserted that the limitation "a value of the particular one compatibility parameter of said ALG
file is added to a value of another particular one compatibility parameter of said ALG file as a
sum that is compared to a value of the compatibility feature of said bi-directional
communications device" was not previously disclosed. The Applicant respectfully disagrees.

    For example, the above limitation, recited in both Claims 24 and 30, may be
correlated to the Applicant's specification as follows: a value of the particular one
compatibility parameter of said ALG file (ALG header size, as per the ALG header size field
216) is added to a value of another particular one compatibility parameter of said ALG file
(ALG body size, as per the ALG body size field 224) as a sum that is compared to a value of
the compatibility feature of said bi-directional communications device (capacity of the non-
volatile memory 136). Support for the preceding correlation of the limitations of Claims 24
and 30 the Applicant's specification may be found at least at page 13, lines 4-9 of the
Applicant's specification, which disclose "At step 310, the ALG header size field 216 **and**
ALG body size field 224 in the header 210 of the received ALG file 200 are checked. If at
step 312, **the ALG file 200** exceeds the capacity of the non-volatile memory 136, then
method 300 proceeds to step 350, where the ALG file 200 is rejected as discussed above. If
at step 312, the ALG file 200 does not exceed the capacity of the non-volatile memory 136,
then method 300 proceeds to step 314" (emphasized added). Thus, it is respectfully asserted
that Claims 24 and 30, as well as Claims 25 and 31, are supported by the Applicant's
specification in such a way as to reasonably convey to one skilled in the relevant art that the
inventor(s), at the time the application was filed, had possession of the claimed invention.
Hence, Claims 24, 25, 30, and 31 are believed to satisfy 35 U.S.C. 112, first paragraph.
Reconsideration of the rejection is respectfully requested.

  Claims 1, 2, 4, 11, 12, 14, 16-18, and 21-31 stand rejected under 35 U.S.C. 103(a) as
being unpatentable over U.S. Patent No. 6,986,133 to Michael D. O'Brien et al. (hereinafter
"O'Brien) in view of U.S. Patent Application No. 2002/0152399 to Gregory J. Smith
(hereinafter "Smith"). Claim 13 stands rejected under 35 U.S.C. 103(a) as being unpatentable

over O'Brien in view of Smith, and further in view of U.S. Patent No. 6,031,830 to Paul A. Cowen (hereinafter "Cowen"). The rejections are respectfully traversed.

It is to be noted that Claims 1 and 16 are the pending independent claims in the case.

It is respectfully asserted none of the cited references, either taken singly or in combination, teach or suggest the step of/means for "comparing, at the bi-directional communications device, a particular one compatibility parameter of said ALG file with both a compatibility feature of said bi-directional communications device and a non-signature, non-code-error checking feature expected in received and authentic ALG files by said bi-directional communications device", as recited in Claims 1 and 16.

It is to be further noted that Claims 1 and 16 require by their respective explicit limitations that the particular one compatibility parameter of said ALG file (hereinafter interchangeably referred to as "item 1" for the sake of illustration) is compared with **both** a compatibility feature of said bi-directional communications device (hereinafter interchangeably referred to as "item 2" for the sake of illustration) and a non-signature, non-code-error checking feature expected in received and authentic ALG files by said bi-directional communications device (hereinafter interchangeably referred to as "item 3" for the sake of illustration). Thus, per Claims 1 and 16, item 1 is compared with both item 2 and item 3. That is, the same item 1 is compared to both item 2 and item 3.

In contrast, in setting forth the rejection, the Examiner has also set forth the following reasoning, with respect to items 1 and 2 above: "upgrade policy defining which IP addresses or hostname of the server will provide updates and the 'serverName' component parameter specifying the IP address or host name of the server the agent will inquire about the update" (Office Action, p. 4). Hence, the Examiner seems to be equating the upgrade policy (by hostname) disclosed in O'Brien with recited item 1 (i.e., "particular one compatibility parameter of said ALG file") and the serverName disclosed in O'Brien with recited item 2 (i.e., "compatibility feature of said bi-directional communications device").

Initially, it is respectfully pointed out that if the rollout of the upgrade policy is being controlled by hostname, then the upgrade policy applies to the host (to select the host that is to be used for the rollout) and not to a particular compatibility parameter of said ALG file. For example, the Examiner cited no disclosure in O'Brien where the rollout policy is applied to an ALG file. Moreover, just because a value (e.g., servername) exists does not mean it has to be compared to anything. For example, the value may simply be used. As an example, for an

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upgrade, a particular server may be desired for use without any comparison being necessary. Hence, neither the upgrade policy, the rollout of which is controlled by hostname, or the hostname itself, correspond to the particular compatibility parameter of said ALG file recited in Claims 1 and 16.

Moreover, in continuation of his reasoning for rejecting Claims 1 and 16, the Examiner has pointed to Smith, stating the following at page 5 of the Office Action:

> Smith discloses of a method and system for providing protection from exploits to devices connected to a network by comparing the received file with Q non-signature, non-code-error checking feature expected in received and authentic files [Para. 0065 and 0066; the size of the header or body of the file is examined to determine if they are longer then they should be]. It would have been obvious to one skilled in the art at the time of the invention to verify the header or body length of a particular message to ensure that there is no executable code within the overflow buffers allotted for portions or all of a header or body of a file [Para. 0026]. This allows the system to prevent improper access to data or unauthorized programs executed on the host computer [Para. 0026].

Thus, by the Examiner's rejection, the Examiner has initially correlated the rollout of the upgrade policy (by hostname) to item 1 (i.e., "particular one compatibility parameter of said ALG file") and the server name to item 2 (i.e., "compatibility feature of said bi-directional communications device"), while then equating the header or body length of a particular message to item 3 (i.e., "non-signature, non-code-error checking feature expected in received and authentic ALG files by said bi-directional communications device"). Hence, the Examiner cannot be comparing the same item 1 (per O'Brien) to both item 2 (per O'Brien) and item 3 (per Smith), as do Claims 1 and 16. For one thing, clearly the comparison of the servername/hostname to the header or body length, where the header or body length is examined to determiner whether they are longer than they should be, serves no purpose. That is, if one is examining a header or body length to determine whether they are longer than they should be, then comparing the header or body length to a server name has no utility. Hence, not only does the Examiner's assertion (i.e., comparing the server name to the length of the header or body)

lack support (there is no disclosure in any of the cited references that compares the

servername/hostname to a header or body length) in the cited references, but such assertion seem

illogical and hence, highly improbable.

Moreover, returning to O'Brien, O'Brien simply discloses the **comparing of a digital**

signature, and no more. For example, as explicitly disclosed at column 4, lines 56-64:

> The agent is a small piece of software that runs continuously on a device.
> Its main function is to poll the server for upgrade information and, if an upgrade
> is available, to fetch and apply it to the device. It must also do this securely by
> ensuring that he upgrade has come from an authorized the [sic] server and that
> the contents have not been tampered with during transmission. **The agent**
> **accomplishes this by authenticating and verifying the upgrade via the digital**
> **signature that is included in an upgrade module.**

Moreover, as further disclosed at column 5, lines 25-34 of O'Brien:

> To publish an upgrade, administrators specify the files that constitute the actual
> upgrade (the upgrade payload), as well as configuration and policy information.
> Upgrade policies enable system administrators to control upgrade rollouts by
> specifying which target devices will or will not receive a specific upgrade. The
> payload is then combined with this information and a digital signature to produce
> an upgrade module. **The digital signature is used by the agent to authenticate**
> **the server and to verify the integrity of the upgrade data.**

Hence, there is not disclosure in O'Brien of comparing a single item (namely, "a

particular one compatibility parameter of said ALG file") to two other items (namely "a

compatibility feature of said bi-directional communications device" and "a non-signature, non-

code-error checking feature expected in received and authentic ALG files by said bi-directional

communications device"), as recited in Claim 1. O'Brien is simply comparing the digital

signature. The servername/hostname disclosed in O'Brien merely represents what server is

going to be used to rollout the upgrade. Moreover, Smith does not cure the deficiencies of

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O'Brien and also does not disclose comparing a single item to two other items, as recited in Claim 1.

Hence, none of the cited references, either taken singly or in any combination, teach or suggest all the above recited limitations of Claims 1 and 16.

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art" (MPEP §2143.03, citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)). "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious" (MPEP §2143.03, citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)).

Claims 2, 4, 9, 11-14, and 21 directly or indirectly depend from Claim 1 and, thus, includes all the elements of Claim 1. Claims 17-18 directly or indirectly depend from Claim 16 and, thus, includes all the elements of Claim 16. Accordingly, Claims 2, 4, 9, 11-14, and 21 are patentably distinct and non-obvious over the cited references for at least the reasons set forth above with respect to independent Claim 1, and Claims 17-18 are patentably distinct and non-obvious over the cited references for at least the reasons set forth above with respect to independent Claim 16.

Moreover, said dependent claims include patentable subject matter in and of themselves and are, thus, patentable distinct and non-obvious over the cited references in their own right. For example, it is respectfully asserted that none of the cited references, either taken singly or in any PROPER combination, teach or suggest "wherein said bi-directional communications device comprises a cable modem", as recited in Claims 11 and 18.

For example, it is respectfully pointed out that the Examiner is equating server with bi-directional communication device for Claims 1 and 16, while equating a modem with the bi-directional communication device for Claims 11 and 18. Hence, the Examiner's position is inconsistent and unfair, and the rejection of Claims 11 and 18 is deficient using such reasoning.

Further, it is to be noted that while each of Claims 1 and 16 recite that the "comparing" is performed at the bi-directional communications device, in contrast O'Brien discloses the serverName parameter is sent from the agent to the server in order to inquire about and fetch upgrades and, hence, any comparison of the serverName is performed by the server and not the actual device to be upgraded (i.e., the bidirectional communications device) (see, e.g., O'Brien,

col. 12, lines 48-54). Hence, if the modem of Smith is relied upon (as the Examiner did one pages 4-5 in the Office Action), then clearly the Examiner's entire use of servername/hostname as per Claims 1 and 16 is misplaced, for at least the preceding reasons set forth above.

Hence, should the Examiner select <u>either</u> the server disclosed in O'Brien <u>OR</u> the modem disclosed in Smith as corresponding to the bi-directional communications device recited in Claims 1 and 16, then clearly the limitations of Claim 1 and 11 (or Claims 16 and 18) cannot both be shown in the cited references in any proper combination. Hence, none of the cited references, either taken singly or in any PROPER combination, teach or suggest the above recited limitations of Claims 11 and 18.

Further, it is respectfully asserted that none of the cited references, either taken singly or in any combination, teach or suggest "wherein a value of the particular one compatibility parameter of said ALG file is added to a value of another particular one compatibility parameter of said ALG file as a sum that is compared to a value of the compatibility feature of said bi-directional communications device", as recited in Claims 24 and 30. For example, the cited paragraphs [0065] and [0066] of Smith simply disclose "examine the lengths of fields to determine whether they are longer than they should be", but do not disclose or suggest adding the lengths to obtain a sum that is compared to another value as essentially recited in Claims 24 and 30. Moreover, none of the remaining references cure the deficiencies of Smith. Hence, none of the cited references, either taken singly or in any combination, teach or suggest the above recited limitations of Claims 24 and 30.

Accordingly, reconsideration of the rejections is respectfully requested.

In view of the foregoing, Applicants respectfully request that the rejection of the claims set forth in the Office Action of June 20, 2008 be withdrawn, that pending Claims 1-2, 4, 11-14, 16-18, and 21-31 be allowed, and that the case proceed to early issuance of Letters Patent in due course.

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A petition for extension of time under 37 CFR 1.136(a), and payment of the appropriate fee for a one (1) month extension of time for this response, was made under separate and concurrently filed cover – therefore, the response is considered timely (with the one month extension). It is believed that no further additional fees or charges are currently due. However, in the event that any additional fees or charges are required at this time in connection with the application, they may be charged to applicants' Deposit Account No.07-0832.

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Respectfully submitted,

John Alan Gervais et al.

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By: /Guy Eriksen/

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